

Serial No. 10/824,890  
Amdt. Dated February 8, 2006  
Reply to Restriction Requirement of December 8, 2005

Remarks

The Examiner requested election to one of the following of what he believes are patentably distinct inventions:

Species I: FIGs. 1-6;  
Species II: FIGs. 7-9;  
Species III: FIGs. 10-15;  
Species IV: FIGs. 16-17;  
Species V: FIG. 28;  
Species VI: FIG. 29;  
Species VII: FIG. 30;  
Species VIII: FIG. 31.

The present application was filed nearly two years ago and there has not yet been a substantive examination. Applicant is now surprised to receive the present restriction requirement that requests the applicant to select one of eight (8) of what the Examiner concluded are patentably distinct species of the claimed invention. For the following reasons, this election is made with traverse and applicant respectfully requests that the Examiner reconsider this restriction requirement.

As provided under 35 U.S.C. § 121:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. (*Emphasis added*)

The term "independent" (i.e. not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect. MPEP § 802.01. The term "distinct" means that two or more subjects as disclosed are

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related, . . . but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and obvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). MPEP § 802.01. A restriction requirement is improper if either of the independent and distinct definitions is not met by the embodiments of the claimed invention. The embodiments designated by the Examiner are not independent because, as outlined below, they are connected in design and operation.

Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper. MPEP § 806. In the present application, the embodiments of the invention are related as disclosed and are not distinct as claimed. The specification generally describes a flexible lighting system, a system for lighting structural features using the flexible lighting systems; and illuminated sign having a plurality of sign features using flexible lighting systems. Each of the species identified by the examiner are related to the same flexible lighting system.

In the present restriction requirement the Examiner improperly focused on the figures in the specification. In passing upon the question of restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence. MPEP § 806.1. By focusing on the figures, the Examiner incorrectly concluded that the disclosure included eight (8) species.

Even if we were to assume, for argument sake alone, that the present invention includes more than one


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invention, the Examiner should still search and examine the entire application. If the search and the examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions. MPEP § 803. All of the embodiments of the invention are to the flexible lighting system or applications for the flexible lighting systems. Search and examination can be made to the embodiments without serious burden.

Applicants respectfully request that the Examiner withdraw the present restriction requirement and that action on claims 1-36 proceed on the merits. If the Examiner chooses not to withdraw the present restriction requirement, Applicants elect the claims to identified Species 1; FIGs. 1-6. This species covers claims 1-13, 15, 17, 18 and 39-48.

Respectfully submitted,

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